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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,412	01/09/2004	Hiroyuki Takeuchi	018995-741	6381
21839	7590	02/11/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			PADEN, CAROLYN A	
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/753,412	TAKEUCHI ET AL.	
	Examiner	Art Unit	
	Carolyn A Paden	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2 VARIOUS</u> . | 6) <input type="checkbox"/> Other: _____ |

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly-owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Babayan (3,450,819) and see example 8 and column 5 lines 70-75.

Babayan discloses a synthetic therapeutic fat. At example 4, the dietetic food is stated to supply valuable energy without the tendency to

deposit fat in the body. At example 8, a mixture of cod liver oil and capric-caprylic glyceride is shown. It is well known in the art that capric acid is the common name for C10 fatty acid while caprylic is the common name for a C8 fatty acid. Thus example 8 and example 4 in Babayan anticipate the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babayan (3,450,819) in view of Paparnandjaus.

Babayan discloses a synthetic therapeutic fat. At example 4, the dietetic food is stated to supply valuable energy without the tendency to deposit fat in the body. At example 8, a mixture of cod liver oil and capric-caprylic glyceride is shown. It is well known in the art that capric acid is the common name for C10 fatty acid while caprylic is the common name for a C8 fatty acid. Thus example 8 and example 4 in Babayan anticipate the claims. The claims appear to differ from Babayan in the recitation that MCT is a regulator for body fat. Paparnandjaus teaches the use of MCT for

the treatment of obesity at pages 1208-1212. Thus it would have been obvious at the time of applicant's invention to use the composition of

~~Babayan as a fat regulator, especially in view to the suggestion in~~

Paparnandjaus to utility in the treatment of obesity. It is appreciated that vitamin E is not disclosed in Babayan but vitamins are a suggested additive in Babayan at column 7, line 35. It is also appreciated that phytosterols are not mentioned in Babayan. But phytosterols are known to be natural components of plant oils. Thus one of ordinary skill in the art would expect phytosterols in any composition containing a plant oil, such as in example 15. It is also appreciated that the specific weight loss in overweight individuals, set forth in claim 7, is not disclosed. But MCT has already been shown or implied as being useful in treating obesity. In applicant's example study, overweight people are placed on a diet regime which is probably substantially different from their regular enhanced calorie diet.

Thus one of ordinary skill in the art would expect those people to lose more weight than the regular individuals because their caloric consumption and activity levels might probably be substantially different from normal. With regard to claim 9, Babayan is directed to a rat feed that has an edible oil in

it. But to utilize the oil of Babayan in any food product of claim 9 would have been an obvious use for the oil of Babayan to treat obesity.

~~Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable~~
over Seiden (5,288,512) in view of Babayan (3,450,819).

Seiden discloses reduced calorie fats that contain MCT. In the examples, the MCT fat is used in frozen deserts and in a chocolate coating for ice cream. The claims appear to differ from Seiden in the use of the particular oil of claim 1. Babayan teaches this particular oil. To use the oil of Babayan for the oil of Seiden would have been an obvious substitution of one known MCT oil for another in an edible oil formulation.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Menz (3,658,555) in view of Babayan (3,450,819).

Menz discloses a fat spread containing MCT. The claims appear to differ from Menz in the use of the particular oil of claim 1. Babayan teaches this particular oil. To use the oil of Babayan for the oil of Menz would have been an obvious substitution of one known MCT oil for another in an edible oil formulation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone

number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

~~If attempts to reach the examiner by telephone are unsuccessful, the~~
examiner's supervisor, Milton Cano, can be reached on (571) 272-1398 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CAROLYN PADEN 2-11-05
PRIMARY EXAMINER 1761